

Serial No. 10/670,502

Attorney Docket No. 26A-010

REMARKS

Claims 21-23 and 25-35 are pending. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 21-23 and 26-35 were rejected under 35 USC 103(a) as being anticipated by U.S. Patent No. 5,628,944, Nagasaka et al. ("Nagasaka") in view of U.S. Patent No. 4,882,107, Cavender et al. ("Cavender"). Claim 25 was rejected under 35 USC 103(a) as being unpatentable over Nagasaka in view of U.S. Patent No. 3,768,232, Farber ("Farber").¹

Independent claims 21, 29 and 34 are amended. Support for the amendment is located in the original application, for example, page 8, lines 17-21 and page 22, lines 7-13 (a first liquid consisting of a releasing agent and a solvent is injected into a closed cavity prior to supplying a molding material forming a molded portion to the closed cavity); page 11, lines 9-14, page 12, lines 10-17, and FIG. 5 (boiling the solvent of the releasing agent in the closed cavity prior to supplying a molding material to the closed cavity); and page 11, lines 16-31 (evacuating the vaporized solvent of the releasing agent from the closed cavity prior to supplying a molding material to the closed cavity). Insofar as the rejection can be applied to the claims as amended, the rejection is respectfully traversed for reasons including the following, which are provided by way of example.

Independent claim 21 recites in combination, for example, "forming a releasing agent layer, the releasing agent layer being composed of a releasing agent, adhered to a wall surface of a cavity of a mold that is in a closed state by injecting a first liquid consisting of the releasing agent and a solvent into the closed cavity prior to supplying a molding material forming a

¹ Claim 25 depends from claim 21. Although claim 21 was rejected over Nagasaka and Cavender, the rejection of claim 25 omitted citing Cavender. The following discussion assumes that the office action intended to cite Nagasaka, Cavender and Farber in rejecting claim 25.

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molded portion to the closed cavity, depressurizing the closed cavity to boil the solvent in the closed cavity prior to supplying the molding material to the closed cavity, and evacuating the vaporized solvent from the closed cavity prior to supplying the molding material to the closed cavity; and thereafter forming the molded portion by supplying a molding material into the closed cavity after the releasing agent layer is formed.” (See also independent claims 29, 34.)

Accordingly, a first liquid consisting of a releasing agent and a solvent is injected into a closed cavity prior to supplying a molding material to the closed cavity. The solvent of the first liquid is boiled in the closed cavity prior to supplying a molding material to the closed cavity. Moreover, a vaporized solvent of the releasing agent is evacuated from the closed cavity prior to supplying a molding material to the closed cavity. Further, a releasing agent layer is formed on the cavity surface prior to supplying a molding material to the closed cavity.

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, it is necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.* No. 04-1350 (U.S. Apr. 30, 2007).

The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

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The applicants provide herein a selection of some examples of limitations in the claims which are neither taught nor suggested by Nagasaka. The Office Action admits that Nagasaka “does not show forming a release agent layer by injecting a liquid consisting of a releasing agent and a solvent.” (Office Action, page 2). Recognizing that Nagasaka fails to teach and/or suggest the invention as claimed, Cavender is cited to remedy the deficiencies. However, Nagasaka is clearly deficient considering the invention as presently claimed as a whole. Cavender fails to remedy such deficiencies.

For example, Nagasaka fails to teach or suggest “injecting a first liquid consisting of the releasing agent and a solvent into the closed cavity prior to supplying a molding material forming a molded portion to the closed cavity” (claims 21, 29; see also claim 34). To the contrary, according to Nagasaka, the release agent is injected into a cavity at the same time as supplying the molding material (col. 7, lines 32-47.) Cavender does not remedy this deficiency.

Furthermore, Nagasaka fails to teach or suggest “depressurizing the closed cavity to boil the solvent in the closed cavity prior to supplying the molding material to the closed cavity” (claims 21, 29; see also claim 34). To the contrary, in Nagasaka, a solvent of Nagasaka dissolving a release agent is injected into a cavity at the same time that the molding material is supplied. Therefore, in Nagasaka, a solvent dissolving the release agent cannot be boiled in the closed cavity prior to supply a molding material to the closed cavity. Cavender does not remedy this deficiency.

Moreover, Nagasaka fails to teach or suggest “evacuating the vaporized solvent from the closed cavity prior to supplying the molding material to the closed cavity” (claims 21, 29; see also claim 34). To the contrary, Nagasaka’s solvent dissolving release agent is injected into the cavity at the same time the molding material is supplied. Therefore, in Nagasaka, a vaporized

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solvent used to dissolve the release agent cannot be evacuated from the closed cavity prior to supplying a molding material to the closed cavity. Cavender does not remedy this deficiency.

Also, Nagasak fails to teach or suggest forming a releasing agent layer on the cavity surface "prior to supplying a molding material ... to the closed cavity" (claims 21, 29; see also claim 34). To the contrary, Nagasaka's method cannot form a releasing agent layer prior to supplying a molding material to the closed cavity for reasons including those discussed above. Cavender does not remedy this deficiency.

Hence, Nagasaka and Cavender, alone or in combination with the other references of record, fail to teach or suggest the combination of features recited in independent claims 21, 29, or 34, when considered as a whole.

With respect to the rejected dependent claims, applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claims 21, 29, or 34, but also because of additional features they recite in combination.

The applicants respectfully submit that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples the applicants have described herein in connection with distinguishing over the cited art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited references.

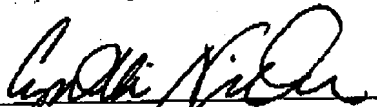
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In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,


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